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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,339	09/08/2000	Mark E. Ogram	1475B.5A.5	8051

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 01/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/654,339

Applicant(s)

OGRAM, MARK E.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.

2. The Abstract of the Disclosure is objected to because:
 - (1) applicant's use of a "□" at lines 4 & 7 of the abstract, "A method of operating ... the customer□s account ... the merchant□s computer) on the network.", is confusing..

Correction is required. See M.P.E.P. § 608.01(b).

3. The disclosure is objected to because of the following informalities:
 - A) applicant must update:
 - (1) the continuing data on page 1;
with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.
 - B) the following errors have been noted in the specification:
 - (1) applicant's use of a "□" in the paragraph at page 1, lines 2-9, "This is a continuation of ... entitled □Financial ... Computers□ ... entitled □Financial ... Computers□ ... entitled □An ... System□ ... on October 13, 1998.", is confusing.
 - (2) applicant's use of a "□" in the paragraph at page 16, lines 4-9, "A determination, based ... is a □service□, ... skis to step 44P.", is confusing.
 - (3) applicant's use of the word "skis" at line 6 of the paragraph at page 16, lines 4-9, "A determination, based ... skis to step 44P.", is confusing. As can be seen in fig. 4B and from the context of this paragraph at line 6 "skis" should be -skips--.
 - C) The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the

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embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

(1) applicant's use of web address in:

(a) the paragraph bridging pages 5 & 6, "By selective use of ... <http://merchant.com/widget.>"; and

(b) the paragraph at page 6, lines 2-5, "When the merchant ... <http://merchant.com/widget/blue.>";

is improper, since:

(a) in electronic versions of the patent grant this address would create an improper hyper link to the specified address; and

(b) the content of the specified web address may change over time and, hence, would add new matter and/or alter the content/teachings of the instant disclosure over time.

Hence, applicant should delete the <http://> from page 6, lines 1 & 5.

Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(g)-1.121(h).

5. Claims 1-14 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-10 of copending Application No. 09/400,724. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

5.1 Claims 1-14 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-4 & 13-15 of copending Application No. 09/657,277. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

5.2 Claims 1-14 are rejected under the judicially created doctrine of double patenting over claims 1-26 of U. S. Patent No. 5,822,737 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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5.3 Claims 1-14 are rejected under the judicially created doctrine of double patenting over claims 1-7 of U. S. Patent No. 5,963,917 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

5.4 The subject matter claimed in the instant application is fully disclosed in the referenced patents and copending applications and would be covered by the referenced patents or any patent granted on either of the copending applications since the referenced patents and copending applications and the instant application are claiming common subject matter, as follows:

A) a payment processing system which accepts customer account and amount data over a communications network from a remote computer;

B) processes the customer account and amount data to create an authorization indicia; and

C) returning an indication of the authorization indicia to the remote computer.

5.5 Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5.6 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5.7 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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5.8 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(102(e) only) The changes made to 35 U.S.C. § 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. § 122(b). Therefore, this application is examined under 35 U.S.C. § 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

6.1 Claims 1-14 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Chasek (5,420,405).

6.2 Claims 1-14 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Gorog (4,947,028) or Teicher (5,206,488).

6.3 Claims 1-14 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by either Rosen (5,557,518 or 5,671,280 or 5,703,949 or 5,878,139) or Chelliah et al

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(5,710,887) or Payne et al (5,715,314 or 5,909,492) or Gifford (5,742,424) or Manasse (5,802,497) or Sirbu et al (5,809,144).

6.4 In regard to claims 1-14, any one of Gorog ('028) or Teicher ('488) or Chasek ('405) or Rosen ('518 or '280 or '949 or '139) or Chelliah et al ('887) or Payne et al ('314 or '492) or Gifford ('424) or Manasse ('497) or Sirbu et al ('144) disclose a remote purchasing system in which accept customer's account, i.e. checking/debit/credit number, and amount data over a communications network from authorized customer at a remote computer, processes the customer account and amount data to create an authorization indicia, and returns an indication of the authorization indicia to the remote computer.

6.4.1 It is noted that:

A) the internet and a telephone network are both communications networks.

B) a customer's password is used as part of a common method of determining if a customer is authorized.

7. The examiner has cited prior art of interest, for example:

A) Watanabe et al (5,352,876) which disclose a payment processing system which accepts customer's account and amount data over a communications network from a remote computer, processes the customer account and amount data to settle the transaction.

B) either the New Zealand Herald article or Stuck or Fujioka (JP 11-053444) or the BusinessWorld article or Rowney et al (5,987,140) or Synesiou et al (5,959,549) or Mann et al (6,119,096) which disclose a payment processing system which accepts customer's account and amount data over a communications network from a remote computer, processes the customer account and amount data to create an authorization indicia, and returns an indication of the authorization indicia to the remote computer.

8. The prior art cited in parent applications Serial No. 08/597,017 filed February 05,1996 and Serial No. 09/166,749 filed October 05,1998 and serial number 09/400,724 filed September 21, 1999 has been considered by the examiner.

8.1 Prior art cited but not supplied to applicant, has been previously supplied to applicant during the prosecution of the parent applications.

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9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)-305-9768. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 746-7239.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 746-7238.

01/12/02


Edward R. Cosimano
Primary Examiner A.U. 2161